UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,124	10/31/2003	William M. Shapiro	07844-621001	4993

21876   7590   05/13/2008
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EXAMINER
CERVETTI, DAVID GARCIA

ART UNIT	PAPER NUMBER
2136	

MAIL DATE	DELIVERY MODE
05/13/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/699,124	SHAPIRO ET AL.
	Examiner	Art Unit	
	DAVID CERVETTI	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>10 March 2008</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-19,21-41 and 43-57</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-19,21-41 and 43-57</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>31 October 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/10/08</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   Applicant's arguments filed March 10, 2008, have been fully considered.

2.   Claims 1-19, 21-41, and 43-57 are pending and have been examined.

Response to Amendment

3.   Applicant's arguments with respect to the prior art have been considered but are

moot in view of the new ground(s) of rejection.

4.   Regarding claims 19 and 20, Examiner submits that Garcia teaches using

encryption and also suggests using any other encryption algorithms, as such,

anticipates the claimed subject matter.

Continued Examination Under 37 CFR 1.114

5.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114.

Claim Objections

6.   Claims 35-38 and 40 are objected to because of the following informalities: they

are written as dependent from claim 33, perhaps claim 34 was intended. Appropriate

correction is required.

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

8.   Claims 45-57 are not limited to tangible embodiments. In view of applicants'

disclosure (pars. 88-89), the server and the client are not limited to hardware, but can

be software, and according to the art, a server/client can consist on software routines.

As such, the claims are not limited to statutory subject matter and is therefore non-

statutory.

Claim Rejections - 35 USC § 102

9.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

10.   Claims 19, 21-22, 41, and 43-44 are rejected under 35 U.S.C. 102(e) as being

anticipated by Garcia (US Patent 7,178,033).

        Regarding claims 19 and 41, Garcia teaches

encrypting an electronic document **(col. 11, lines 55-67)**; and incorporating into

the encrypted electronic document an address of a document control server, document-

permissions information, and an encryption key useable in decrypting the encrypted

electronic document, the encryption key being encrypted with a key generated by, and

associated with a group of users of, the document control server;

        wherein the encryption key comprises a session key generated by the document

control server, encrypting the electronic document comprises encrypting the electronic

document using a document key, and incorporating comprises incorporating into the

encrypted electronic document a document security payload comprising the document

key and the document-permissions information, the document security payload being

encrypted using the session key **(col. 7, lines 45-67, col. 11, lines 40-67, col. 12, lines
1-65)**.

      Regarding claims 21 and 43, Garcia teaches wherein the document security
payload further comprises a document identifier assigned by the document control
server, and incorporating further comprises incorporating into the encrypted electronic
document a copy of the session key encrypted using a public key associated with the
document control server **(col. 11, lines 40-67, col. 12, lines 1-65)**.

      Regarding claims 22 and 44, Garcia teaches wherein the document-
permissions information specifies access permissions at a level of granularity smaller
than the electronic document **(col. 11, lines 40-67, col. 12, lines 1-65)**.

Claim Rejections - 35 USC § 103

11.   The text of those sections of Title 35, U.S. Code not included in this action can
be found in a prior Office action.

12.   **Claims 1-8, 10-17, 23-30, 32-39, and 45-57 are rejected under 35
U.S.C. 103(a) as being unpatentable over Garcia, and further in view of Altenhofen
et al. (US Patent Application Publication 2003/0232318, hereinafter Altenhofen).**

      Regarding claims 1 and 23, Garcia teaches receiving a request from a client to
take an action with respect to a first electronic document **(col. 11, lines 55-67)**; and
synchronizing access information with the client in response to the request, to authorize
the client, to allow actions by a user as a member of a group of users, by sending to the
client an update to access information retained at the client, the update comprising a
first key associated with the group, the first key being useable at the client to access a

second electronic document while offline by decrypting a second key in the second

electronic document **(col. 11, lines 40-67, col. 12, lines 1-31)**.

Garcia does not expressly disclose synchronization of offline access information

or pre-authorizing the client. However, Altenhofen teaches synchronizing offline access

and pre-authorizing the client (pars. 80-84, client allows/block access and synchronizes

access information).

Therefore, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to synchronize offline access and pre-authorize the

client. One of ordinary skill in the art would have been motivated to perform such a

modification to keep track of offline access and user progress to intellectual property

(Altenhofen, pars. 5-7, 13-14).

Regarding claims 12 and 34, Garcia teaches with receiving a document control

server, when online, <u>to access to an electronic document, the synchronizing comprising</u>

<u>receiving an update to</u> offline access information retained <u>locally, the update</u> comprising

a first key associated with a group of users of the document control server **(col. 11,**

lines 55-67); and allowing access to the electronic document, when offline, by

performing operations comprising using the first key to decrypt a second key in the

electronic document and governing actions with respect to the electronic document

based on document-permissions information associated with the electronic document

(col. 11, lines 40-67, col. 12, lines 1-31).

Garcia does not expressly disclose synchronization of offline access information

or pre-authorizing the client. However, Altenhofen teaches synchronizing offline access

and pre-authorizing the client (pars. 80-84, client allows/block access and synchronizes access information).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to synchronize offline access and pre-authorize the client. One of ordinary skill in the art would have been motivated to perform such a modification to keep track of offline access and user progress to intellectual property **(Altenhofen, pars. 5-7, 13-14)**.

Regarding claims 45 and 56, Garcia teaches a document control server that synchronizes information with a client in response to a client request, to authorize offline access to an electronic document by sending an update to the offline access information retained at the client, the update comprising a first key associated with a group, the first key being useable at the client to access the electronic document by decrypting a second key in the electronic document **(col. 11, lines 40-67)**; and the client that allows access to the electronic document, when offline, by a user as a member of the group, using the first key to decrypt the second key in the electronic document and governing actions with respect to the electronic document based on document-permissions information associated with the electronic document **(col. 11, lines 40-67, col. 12, lines 1-31)**.

Garcia does not expressly disclose synchronization of offline access information or pre-authorizing the client. However, Altenhofen teaches synchronizing offline access and pre-authorizing the client (pars. 80-84, client allows/block access and synchronizes access information).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to synchronize offline access and pre-authorize the client. One of ordinary skill in the art would have been motivated to perform such a modification to keep track of offline access and user progress to intellectual property **(Altenhofen, pars. 5-7, 13-14)**.

Regarding claim 2 and 24, the combination of Garcia and Altenhofen teaches synchronizing offline access information with the client comprises comparing a time of last recorded client-synchronization with a time of last change in user-group information for the user (Altenhofen, pars. 80-84, client allows/block access and synchronizes access information).

Regarding claims 3 and 25, the combination of Garcia and Altenhofen teaches synchronizing offline access information with the client comprises <u>receiving user-group information for the user from the client; and </u>comparing current user-group information for the user with the received user-group information for the user from the client (Altenhofen, pars. 80-84, client allows/block access and synchronizes access information).

Regarding claims 4 and 26, the combination of Garcia and Altenhofen teaches wherein the client allows actions with respect to the second electronic document based on document-permissions information residing in the second electronic document **(Garcia, col. 13, lines 40-67, Altenhofen, pars. 45-48)**.

Regarding claims 5 and 27, the combination of Garcia and Altenhofen teaches wherein the offline access information update further comprises document-permissions

information associated with multiple documents, including the second electronic

document, and the client allows actions with respect to the second electronic document

based on the document-permissions information **(col. 13, lines 40-67, col. 14, lines 22-**

67).

      Regarding claims 6 and 28, the combination of Garcia and Altenhofen teaches

wherein synchronizing offline access information with the client comprises

synchronizing silently in a background process without the user being aware of the

update (Altenhofen, pars. 80-84, client allows/block access and synchronizes access

information).

      Regarding claims 7 and 29, the combination of Garcia and Altenhofen teaches

<u>wherein the request requires authentication, the method</u> further comprising verifying the

user at the client as an authenticated user **(Garcia, col. 13, lines 40-67, Altenhofen,**

pars. 80-84, client allows/block access and synchronizes access information).

      Regarding claims 8 and 30, the combination of Garcia and Altenhofen teaches

wherein the offline access information update further comprises: at least one user-

specific key; at least one group-specific key, including the first key; and at least one set

of document-permissions information associated with multiple documents **(col. 7, lines**

45-67, col. 13, lines 40-67, col. 14, lines 22-67).

      Regarding claims 10 and 32, the combination of Garcia and Altenhofen teaches

wherein the at least one set of document-permissions information comprises one or

more policies associated with the first document, and the offline access information

update further comprises a document revocation list **(Garcia, col. 13, lines 40-67, col. 14, lines 22-67)**.

      Regarding claims 11 and 33, the combination of Garcia and Altenhofen teaches wherein the offline access information update further comprises at least one set of document-permissions information associated with a specific document, selected based on synchronization prioritization information **(Garcia, col. 13, lines 40-67, col. 14, lines 22-67, Altenhofen, pars. 80-84, client allows/block access and synchronizes access information)**.

      Regarding claims 13 and 35, the combination of Garcia and Altenhofen teaches wherein governing actions with respect to the electronic document comprises obtaining the document-permissions information from the electronic document **(Garcia, col. 13, lines 40-67, col. 14, lines 22-67)**.

      Regarding claims 14 and 36, the combination of Garcia and Altenhofen teaches wherein governing actions with respect to the electronic document comprises: identifying a document policy reference in the electronic document; and obtaining locally retained document-permissions information based on the document policy reference **(Garcia, col. 13, lines 40-67, col. 14, lines 22-67)**.

      Regarding claims 15 and 37, the combination of Garcia and Altenhofen teaches wherein the offline access information update comprises at least one user-specific key, at least one group-specific key, including the first key, at least one set of document-permissions information associated with multiple documents, and a document revocation list **(Garcia, col. 7, lines 45-67, col. 13, lines 40-67, col. 14, lines 22-67)**.

Regarding claims 16 and 38, the combination of Garcia and Altenhofen teaches preventing access to the document, when offline, if a difference between a current time and a receipt time of the offline access information exceeds a server-synchronization-frequency parameter **(Garcia, col. 11, lines 40-67, col. 12, lines 32-65, fig. 3B)**.

Regarding claims 17 and 39, the combination of Garcia and Altenhofen teaches wherein the server-synchronization- frequency parameter is specific to the document **(Garcia, col. 11, lines 40-67, col. 12, lines 32-65, fig. 3B)**.

Regarding claim 46, the combination of Garcia and Altenhofen teaches wherein the electronic document comprises the document-permissions information **(Garcia, col. 11, lines 40-67, col. 12, lines 1-65)**.

Regarding claim 47, the combination of Garcia and Altenhofen teaches wherein the second key comprises a session key generated by the document control server, and the electronic document further comprises a document security payload comprising a document key and the document-permissions information, the document security payload being encrypted using the session key **(Garcia, col. 7, lines 45-67, col. 11, lines 40-67, col. 12, lines 1-65)**.

Regarding claim 48, the combination of Garcia and Altenhofen teaches wherein the offline access information update further comprises: at least one user-specific key; at least one group-specific key, including the first key; and at least one set of document-permissions information associated with multiple documents **(Garcia, col. 7, lines 45-67, col. 13, lines 40-67, col. 14, lines 22-67, Altenhofen, pars. 80-84, client allows/block access and synchronizes access information)**.

Regarding claim 49, the combination of Garcia and Altenhofen teaches wherein the client comprises an agent that periodically contacts the document control server to synchronize the offline access information **(Altenhofen, pars. 80-84, client allows/block access and synchronizes access information)**.

Regarding claim 50, the combination of Garcia and Altenhofen teaches wherein the document control server comprises: a server core with configuration and logging components; an internal services component that provides functionality across dynamically loaded methods; and dynamically loaded external service providers, including one or more access control service providers **(Garcia, col. 16, lines 31-67, Altenhofen, fig. 9)**.

Regarding claim 51, the combination of Garcia and Altenhofen teaches a business logic tier comprising a cluster of document control servers, including the document control server; an application tier including the client comprising a viewer client, a securing client, and an administration client; and a load balancer that routes client requests to the document control servers **(Garcia, col. 15, lines 29-67, col. 16, lines 1-31, Altenhofen, fig. 9)**.

Regarding claim 52, the combination of Garcia and Altenhofen teaches wherein the client request comprises a request from the client to take an action with respect to a second document, and the document control server synchronizes offline access information with the client silently in a background process without the user being aware of the update **(Garcia, col. 15, lines 29-67, col. 16, lines 1-31, Altenhofen, pars. 80-84, client allows/block access and synchronizes access information)**.

Regarding claim 53, the combination of Garcia and Altenhofen teaches wherein the document control server comprises a permissions-broker server including a translation component, the second document comprises a document secured previously by the permissions-broker server, and the translation component being operable to translate first document-permissions information in a first permissions-definition format into second document-permissions information in a second permissions-definition format in response to the request being received from the client **(col. 15, lines 29-67, col. 16, lines 1-31)**.

Regarding claim 54, the combination of Garcia and Altenhofen teaches wherein the server comprises a permissions- broker server operable to identify information associated with the second document in response to the request, the associated information being retained at the server and indicating a third electronic document different from and associated with the second document, the server being operable to relate information concerning the third electronic document to the client to facilitate the action to be taken **(col. 15, lines 29-67, col. 16, lines 1-31)**.

Regarding claim 55, the combination of Garcia and Altenhofen teaches wherein the server comprises a permissions- broker server operable to obtain and send, in response to the request, a software program comprising instructions operable to cause one or more data processing apparatus to perform operations effecting an authentication procedure, and the client uses the authentication program to identify a current user and control the action with respect to the second document based on the

current user and document-permissions information associated with the second

document **(col. 15, lines 29-67, col. 16, lines 1-31)**.

      Regarding claim 57, the combination of Garcia and Altenhofen teaches server

means for dynamically obtaining and sending authentication processes in response to

client requests to take actions with respect to electronic documents; and client means

for interfacing with a received authentication process to identify a current user and for

controlling actions with respect to electronic documents based on the current user and

document-permissions information **(col. 15, lines 29-67, col. 16, lines 1-31)**.

13.   **Claims 9, 18, 31, and 40 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Garcia and Altenhofen, and further in view of DeMarines (NPL

"Authentica: Content Security for the Enterprise").

      Regarding claims 9 and 31, the combination of Garcia and Altenhofen does not

expressly disclose receiving an offline audit log from the client. However, DeMarines

teaches receiving an offline audit log from the client **(page 10)**. Therefore, it would have

been obvious to one having ordinary skill in the art at the time the invention was made

to provide offline audit logs. One of ordinary skill in the art would have been motivated

to perform such a modification to keep track of offline access to secured files

(DeMarines, pp. 2-3).

      Regarding claims 18 and 40, the combination of Garcia and Altenhofen does

not expressly disclose maintaining an offline audit log; and uploading the offline audit

log when online. However, DeMarines teaches maintaining an offline audit log; and

uploading the offline audit log when online **(page 10)**. Therefore, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to

provide offline audit logs. One of ordinary skill in the art would have been motivated to

perform such a modification to keep track of offline access to secured files **(DeMarines,**

pp. 2-3).

Conclusion

14.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to DAVID CERVETTI whose telephone number is
(571)272-5861. The examiner can normally be reached on Monday-Tuesday and
Thursday-Friday.

15.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Nasser Moazzami can be reached on (571)272-4195. The fax phone
number for the organization where this application or proceeding is assigned is 571-
273-8300.

16.   Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
Status information for unpublished applications is available through Private PAIR only.
For more information about the PAIR system, see http://pair-direct.uspto.gov. Should
you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a
USPTO Customer Service Representative or access to the automated information
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David García Cervetti/
Examiner, Art Unit 2136

/Brandon S Hoffman/
Primary Examiner, Art Unit 2136